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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/539,461	01/28/2008	John Guest	033327.0024	8391
1209	7590	09/16/2010		
Thomas F. Bergert c/o WILLIAMS MULLEN IP docketing 222 CENTRAL PARK AVENUE SUITE 1700 VIRGINIA BEACH, VA 23462			EXAMINER ADE, OGER GARCIA	
			ART UNIT 3687	PAPER NUMBER
			NOTIFICATION DATE 09/16/2010	DELIVERY MODE ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary	Application No. 10/539,461	Applicant(s) GUEST ET AL.	
	Examiner GARCIA ADE	Art Unit 3687	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 July 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 69 and 70 is/are pending in the application.
- 4a) Of the above claim(s) 39-68 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) 69-70 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 June 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>07/09/2010</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Status

1. This communication is in response to the Reply of the Election/Restriction filed on **07.06.2010**.

Election/Restrictions

2. Claims 39-68 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected Groups I, II, and III, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on **07.06.2010**.

3. Applicants' election without traverse of Group IV, claims 69-70 in the reply filed on **07.06.2010** is acknowledged. Claims 69-70 are presented for examination below.

Oath/Declaration

4. The Applicants' oath/declaration has been reviewed by the Examiner and is found to conform to the requirements prescribed in **37 C.F.R. 1.63**.

Remark: The Oath or Declaration filed on 05.30.2006 indicates on pages 4 and 5 that John Guest and Brian Tagg are non-signing inventors who cannot be found or be reached, and are former employees of Inca Payments, Ltd. Therefore, the Oath or Declaration is being signed by A. P., Director.

Information Disclosure Statement

5. As required by **M.P.E.P. 609(C)**, the Applicants' submission of the Information Disclosure Statement (IDS) dated 07.09.2010 is acknowledged by the Examiner. The cited references have been considered in the examination of the claims. As required by **M.P.E.P 609 C (2)**, a copy of the PTOL-1449 initialed, signed and dated by the Examiner is attached to the instant Office action.

Priority / Filing Date

6. Applicants' claim for priority of Foreign Application (filed on 12.20.2002) is acknowledged. The Examiner takes the Foreign Application date of 12.20.2002 into consideration.

Claim Rejections - 35 USC § 112

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. **Claim 70** is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

9. It appears the Applicant is attempting to invoke 35 U.S.C. 112, 6th paragraph in Claim 70 by using the phrase "means for" language, such as "means for communicating ..".

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The Phrase "Means for" Is Used, but Unclear Whether the Recited Structure, Material, or Acts in the Claim Are Sufficient for Performing the Claimed Function.

In order to successfully invoke the sixth paragraph, a three-prong test must be met. Namely, (1) the claim must use means-plus-function or step-plus-function language; (2) the claim itself must not provide structural limitations to the means-plus-function, or step-plus-function language; and (3) the specification must recite explicit physical structural limitations for the means-plus-function, or step-plus-function language in the claim. While the above claims pass the first two prongs of the three prong test, they do not pass the third prong.

There is no explicit recitation in the specification of any physical structures to perform the functions of the means-plus-function or step-plus-function limitations in the claim. The only "structure" for performing the functions in the above claims appears to be computer program modules (i.e. virtual structure, not physical structure). Therefore, 35 U.S.C. 112, 6th paragraph has not been successfully invoked. The Examiner will consider the means or steps to perform the claimed functions as any means or steps, physical or virtual, which can perform the function.

If applicant wishes to have the claim limitation treated under 35 U.S.C. 112, sixth paragraph, applicant is required to amend the claim so that the phrase "means for" is clearly not modified by sufficient structure, material, or acts for performing the claimed function.

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If applicant does not wish to have the claim limitation treated under 35 U.S.C. 112, sixth paragraph, applicant is required to amend the claim so that it will clearly not be a means (or step) plus function limitation (e.g., deleting the phrase "means for").

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

12. **Claims 69 and 70** are rejected under 35 U.S.C. 103(a) as being unpatentable over Jaschhof et al. [US 2002/0156728] in view of Kaehler et al. [US 2002/0107610], and further in view of Ginter et al. [US 6,363,488].

As per claims 69 and 70, Jaschhof discloses a method of payment for a product using:

- a mobile radio apparatus having a radio communication circuit and a display capable of displaying an image including a graphical representation of data [see at least the abstract, and as illustrated in figure 1];

- a retail system having a reader capable of reading graphically represented data displayed on said display of said mobile radio apparatus [see at least paragraph 40];
and

- a transaction control system remote from said retail system, said retail system and said transaction control system being capable of communicating over a communications link, said transaction control system storing transaction database records of desired transactions each including data identifying a desired product [see at least summary of the invention], the method comprising the steps of: displaying on said display of said mobile radio apparatus an image including a graphical representation of transaction data which includes data identifying a transaction database record [see at least paragraph 40];

- using said reader of said retail system to read the graphically represented transaction data displayed on said display of said mobile radio apparatus [see at least paragraph 40];

- using said retail system to accept a payment see summary of the invention [see at least summary of the invention]; and

- communicating from said retail system to said transaction control system, the read data identifying a transaction database record and data indicating that payment has been accepted [see at least paragraph 12, via transaction database].

Jaschhof substantially discloses all elements per claimed invention as explained above. Jaschhof does not explicitly disclose a retail system, a reader of said retail system, a transaction control system, displaying an image, updating the transaction database record identified by the communicated data to indicate that payment has been accepted; and delivering the product identified in the identified transaction database record.

However, Kaehler discloses a retail system, a reader of said retail system [see paragraph 27], a transaction control system [see at least the abstract], displaying an image [see claim 30, via image capture], and delivering the product identified in the identified transaction database record [see at least paragraph 37].

Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to incorporate the teaching of Kaehler to the teaching of Jaschhof in order to provide a remote transaction station containing an inventory of products and at least one special product. The remote transaction station dispenses a special product at random to a customer, and vends a product selected by the customer in the same transaction [see summary of the invention of Kaehler].

The above combination substantially discloses all elements per claimed invention as explained above. The combination does not explicitly disclose updating the transaction database. However, Ginter discloses updating the transaction database [as illustrated in figure 35].

Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to incorporate the teaching of Ginter to the teaching

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of the above combination in order to sufficiently provide impede unauthorized and/or uncompensated use of electronic information and/or appliances through the use of secure communication, storage, and transaction management technologies [see summary of the invention of Ginter].

Conclusion

13. The PTO-1449 forms have been reviewed and considered. The following prior art made of record and not relied upon is considered pertinent to Applicants' disclosure:

Horn et al. Pub. No.: US 2002/0156746, teaches a method for transferring an electronic sum of money from a credit memory associated with a money sender to an account or to a credit memory associated with a money receiver via a telecommunications and data network in real time, the necessary connections being set up via a transaction server.

Contact Information

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to GARCIA ADE whose telephone number is (571)272-5586. The examiner can normally be reached on M-F 8:30AM - 5PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Matthew S. Gart can be reached on 571.272.3955. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a SPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Garcia Ade/
Examiner, Art Unit 3687

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Art Unit 3687